

Applicants: Carlos Cordon-Cardo et al.
Serial No.: 10/009,861
Filed: December 10, 2001
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REMARKS

Claims 19 and 28 are pending in the subject application. Applicants have hereinabove cancelled claim 28 without prejudice or disclaimer to their right to pursue the subject matter of this claim in this or a future application. In addition, applicants have hereinabove amended claim 19. Support for this amendment may be found *inter alia* in the specification as follows: support for "overexpression of" Her-2/neu protein in prostate cancer may be found at page 94, lines 29-31 and 34; support for "paclitaxel" and "Herceptin" to treat androgen-independent prostate cancer may be found at page 103, lines 31-37. Applicants maintain that these amendments do not involve any issue of new matter. Therefore, entry of these amendments is respectfully requested such that claim 19 will be pending and under examination.

Withdrawal of Rejections

Applicants acknowledge the Examiner's withdrawal of the obviousness rejection of claims 19 and 28 under 35 U.S.C. §103 and the enablement rejection of claims 19 and 28 under 37 U.S.C. §112, first paragraph.

Claim Rejections Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 19 and 28 under 35 U.S.C. §112, first paragraph, because the specification allegedly does not contain a written description of the claimed invention. The Examiner stated that the limitation of prostate cancer cells which overexpress HER-2/neu protein claimed in claim 19 and 28 has no clear support in the specification and the claims as originally filed.

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The Examiner also stated that the limitation of a method comprising administering a monoclonal antibody which selectively binds to the extracellular domain of HER-2/neu protein claimed in claims 19 and 28 has no clear support in the specification and the claims as originally filed.

The Examiner further stated that the limitation of treatment wherein treatment with the monoclonal antibody and the chemotherapeutic agent inhibits prostate cancer cell growth more than treatment with either the monoclonal antibody alone or the chemotherapeutic agent alone claimed in claims 9 and 28, in the absence of the recitation that the chemotherapeutic agent is paclitaxel, has no clear support in the specification and the claims as originally filed.

In response to the Examiner's rejection of claim 28, but without conceding the correctness thereof, applicants note that this claim has been cancelled without prejudice or disclaimer. Thus, the rejection thereof is moot.

In response to the Examiner's rejection of claim 19, applicants respectfully traverse, noting that claim 19, as amended, addresses the issues set forth above by the Examiner. Specifically, as applicants have pointed out in the "Remarks" section above, support for "overexpression of" Her-2/neu protein in prostate cancer may be found at page 94, lines 29-31 and 34 of the subject specification. In addition, support for using "paclitaxel" in conjunction with "Herceptin" to treat androgen-independent prostate cancer is conceded by the Examiner and may be found at page 103, lines 31-37, of the subject specification. Applicants maintain that these amendments do not involve any

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issue of new matter. Accordingly, applicants contend that claim 19, as amended, satisfies the written description requirement of 35 U.S.C. §112, first paragraph, and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Summary

For the reasons set forth hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the various grounds of rejection and earnestly solicit allowance of pending claim 19.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

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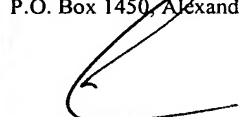
No fee, other than the enclosed \$225.00 fee for a two-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Alan J. Morrison
Reg. No. 37,399

Date

11/30/06